

ESTTA Tracking number: **ESTTA340054**

Filing date: **03/31/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Hearts On Fire Company, LLC
Granted to Date of previous extension	03/31/2010
Address	99 Summer Street Boston, MA 02110 UNITED STATES
Attorney information	Tish L. Berard Hearts On Fire Company, LLC 99 Summer Street Boston, MA 02110 UNITED STATES tberard@heartsonfire.com

Applicant Information

Application No	77636516	Publication date	12/01/2009
Opposition Filing Date	03/31/2010	Opposition Period Ends	03/31/2010
Applicant	Kirk, Alexis Apartment 11C 400 East 58th Street New York, NY 10022 UNITED STATES		


Goods/Services Affected by Opposition

Class 014. First Use: 2006/01/10 First Use In Commerce: 2006/03/10 All goods and services in the class are opposed, namely: Custom made designer jewelry and jeweled accessories, namely, diamonds and diamond jewelry; 14 and 18 karat gold, yellow, green, and white gold, platinum, silver, precious gems, semi-precious gems, precious metals and semi-precious metals for use on earrings, rings, bracelets, necklaces, pendants, pins, broaches, cufflinks, tie pins, scarf holders, buckles, scarf buckles, belt buckles, buckles for clothing, buckles for shoes, buckles for purses, buckles for bags, buckles for cases, hair pins, hair clips, combs, headbands, tiaras, barrettes, jeweled hair vines, hair sticks, clocks, watches, watch straps, wrist bands, key rings of precious metal; jewelry boxes, jewelry cases, pewter jewelry stainless steel jewelry works of art made of gems, precious metal or coated therewith, namely, busts, figurines, statues, statuettes and sculpture, all the aforementioned goods made in significant part of diamonds
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2726434	Application Date	04/11/2001
Registration Date	06/17/2003	Foreign Priority Date	NONE
Word Mark	DREAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 Jewelry		

U.S. Registration No.	2891402	Application Date	10/13/2003
Registration Date	10/05/2004	Foreign Priority Date	NONE
Word Mark	DREAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 Gemstones, namely, cut diamonds		

Attachments	76239211#TMSN.gif (1 page)(bytes) ALEXIS KIRK OPPOSITION_20100331154241.pdf (5 pages)(126480 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Tish L. Berard/
Name	Tish L. Berard
Date	03/31/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HEARTS ON FIRE COMPANY, LLC,)	
)	
OPPOSER,)	
)	
v.)	OPPOSITION NO.
)	
ALEXIS KIRK,)	
)	
APPLICANT.)	
)	

NOTICE OF OPPOSITION

Opposer Hearts On Fire Company, LLC (“HOF”), a Massachusetts limited liability company with a business address of 99 Summer Street, 4th Floor, Boston, Massachusetts 02110, believes that it will be damaged by registration of the mark “Dream Diamonds by Alexis Kirk” that is the subject of application Serial No. 77/636516, filed December 19, 2008, by Alexis Kirk (“Applicant”), and hereby opposes the same and requests that registration to Applicant be refused.

As grounds in support of its opposition, HOF asserts as follows:

OPPOSER, ITS MARKS, AND RELATED GOODWILL

1. Opposer, HOF, is a Massachusetts limited liability company located and doing business at 99 Summer Street, 4th Floor, Boston, Massachusetts 02110.
2. Established in 1996, HOF is a recognized industry leader in the marketing and sale of branded diamonds and jewelry.
3. HOF is headquartered in Boston, Massachusetts, USA, and is rapidly expanding internationally, with regional offices in Canada, Asia, Europe and Latin America.
4. Today, HOF is one of the luxury industry’s fastest growing companies and is recognized as the leading branded diamond company in the world.

5. HOF is and has at all times been actively engaged in the design, manufacture, development, marketing, and sale of a range of jewelry products, including, but not limited to, cut diamonds and jewelry in International Class 14 (collectively, the “Products”).

6. HOF has sold, promoted and marketed its Products under the federally registered U.S. trademarks for its DREAM® marks (Reg. Nos. 2,726,434 and 2,891,402) in connection with jewelry and gemstones (collectively, the “Trademarks”). The Trademarks are valid, existing, unrevoked and uncanceled.

7. HOF first used in commerce the DREAM marks in 2001. HOF’s Trademarks have developed an extraordinary reputation with tremendous goodwill. The Trademarks have come to be associated with luxury, prestige and quality within the jewelry industry. In addition, HOF has been awarded two United States design patents for its unique DREAM® diamond.

8. Since long prior to December 19, 2008, the filing date of Applicant’s application, HOF adopted and commenced use of the Trademarks in connection with the marketing, promoting, offering for sale and selling of the Products.

9. Since long prior to December 19, 2008, HOF has actively, continuously and consistently promoted the Products under the Trademarks on both a national and international basis.

10. As a result of the extensive use and advertising by HOF, the Trademarks have become well known and HOF has built up valuable and substantial goodwill in the Trademarks such that the Trademarks have come to identify HOF’s Products and distinguish HOF’s Products from the products of others.

11. The Trademarks are closely and uniquely associated with HOF and the Products.

APPLICANT'S CONFUSINGLY SIMILAR MARK

12. HOF repeats and realleges the allegations contained in Paragraphs 1-11 of this Notice of Opposition as though fully alleged herein.

13. Upon information and belief, Applicant is an individual residing at Apartment 11C, 400 East 58th Street, New York, New York 10022.

14. On December 19, 2008, Applicant filed an application for Applicant's mark "Dream Diamonds by Alexis Kirk." The application covers the following goods in International Class 14: custom made designer jewelry and jeweled accessories, namely, diamonds and diamond jewelry; 14 and 18 karat gold, yellow, green, and white gold, platinum, silver, precious gems, semi-precious gems, precious metals and semi-precious metals for use on earrings, rings, bracelets, necklaces, pendants, pins, broaches, cufflinks, tie pins, scarf holders, buckles, scarf buckles, belt buckles, buckles for clothing, buckles for shoes, buckles for purses, buckles for bags, buckles for cases, hair pins, hair clips, combs, headbands, tiaras, barrettes, jeweled hair vines, hair sticks, clocks, watches, watch straps, wrist bands, key rings of precious metal; jewelry boxes, jewelry cases, pewter jewelry stainless steel jewelry works of art made of gems, precious metal or coated therewith, namely, busts, figurines, statues, statuettes and sculpture, all the aforementioned goods made in significant part of diamonds (hereinafter "Applicant's Goods"). Upon information and belief, Applicant's Goods are similar to the Products offered by HOF.

15. Applicant's Mark, "Dream Diamonds by Alexis Kirk", is virtually identical to HOF's Trademarks, DREAM®.

16. Upon information and belief, the relevant public would consider HOF's Trademarks and Applicant's Mark to be either highly similar or identical.

APPLICANT'S INFRINGEMENT OF OPPOSER'S MARKS

17. HOF repeats and realleges the allegations contained in Paragraphs 1 through 16 of this Notice of Opposition as though fully alleged herein.

18. Applicant's Mark is confusingly and deceptively similar to the Trademarks such that the use and registration of "Dream Diamonds by Alexis Kirk" by Applicant is likely to create confusion, mistake and deception of the trade and purchasing public.

19. In view of the significant goodwill, distinctiveness, reputation, fame and secondary meaning of the Trademarks of HOF, the use and registration of Applicant's Mark is likely to create confusion, mistake and deception among consumers and will cause or tend to cause consumers to believe that Applicant's Goods originate with or are otherwise licensed, sponsored, or authorized by HOF.

20. By reason of the foregoing, HOF will be gravely damaged by the registration of Applicant's Mark.

21. The grant of registration to Applicant should be denied based on the grounds of trademark infringement pursuant to 15 U.S.C. Sections 1063(a) and 1114.

APPLICANT'S DILUTION OF HOF'S MARKS

22. HOF repeats and realleges the allegations contained in Paragraphs 1 through 21 of this Notice of Opposition as though fully alleged herein.

23. Through the expenditure by HOF of substantial time, money and effort over the years for marketing and promotional activity in the United States and elsewhere, and as a result of the worldwide reputation of the Products emanating from HOF, HOF's Trademarks are "famous" marks within the meaning of 15 U.S.C. Section 1125(c) and are therefore entitled to protection against dilution of their distinctive quality.

24. Upon information and belief, Applicant either has not begun use of its Mark, or did not begin to use Applicant's Mark in any form (including the form now sought to be registered) until long after HOF's Trademarks became famous in the United States.

25. Registration and/or commercial use of Applicant's Mark would cause dilution of the distinctive qualities of HOF's Trademarks by significantly lessening the capacity of HOF's Trademarks to identify and distinguish HOF's Products.

26. Registration and/or commercial use of Applicant's Mark would also cause dilution by tarnishing the high quality and prestige by which HOF's Products have come to be known.

27. The grant of a registration to Applicant for Applicant's Mark as sought in this application (Serial No. 77/636,516) should be denied based on the grounds of dilution of HOF's Trademarks pursuant to 15 U.S.C. Sections 1063(a) and 1125(c).

WHEREFORE, HOF respectfully requests that the Notice of Opposition be sustained and that registration of Applicant's Mark be refused.

Dated: March 31, 2010

HEARTS ON FIRE COMPANY, LLC

By: Tish L. Berard
Tish L. Berard
Hearts On Fire Company, LLC
99 Summer Street
Boston, MA 02110
T: 617-204-4317
F: 617-204-4470
tberard@heartsonfire.com